

REMARKS

In the final Office Action mailed August 3, 2009 ("Final Office Action"), claims 119-143, 145-175, and 177-182 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2006/0185013 ("Oyama"), and claims 144 and 176 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Oyama.

I. Claim Rejection Under 35 U.S.C. § 102(e)

In the Final Office Action, claims 119-143, 145-175, and 177-182 were rejected under 35 U.S.C. § 102(e) as being anticipated by Oyama. Claims 119 and 151 are the only independent claims included in that claim rejection, and Applicant respectfully traverses the rejection of each of independent claims 119 and 151 under § 102(e) based on Oyama at least because the rejection statement has failed to establish that Oyama is eligible as prior art under 35 U.S.C. § 102(e).

As explained in Applicant's Reply to Office Action filed June 5, 2009, in order to qualify as prior art against Applicant's application under 35 U.S.C. § 102(e), Oyama must have been "filed in the United States before the invention by the applicant for patent." 35 U.S.C. § 102(e). "An international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language." Id. Oyama is a national phase of PCT International Application No. PCT/SE04/00945, which was filed on June 15, 2004, designated the United States, and was published in the English language. Thus, the 35 U.S.C. § 102(e) critical reference date of Oyama appears to be June 15, 2004. Applicant's application is a national phase of PCT

International Application No. PCT/EP2004/001105, filed **February 6, 2004** (i.e., before the filing date of Oyama). Preliminary Amendment at 2 and Declaration of Inventorship, both filed August 4, 2006.

As pointed out in the Final Office Action, “Oyama’s PCT filing date is filed on June 15, 2004 but has an earlier priority date with provisional application No. 60/479156 which was filed on June 18, 2003.” Final Office Action at 3. The Final Office Action then concludes, in an unsupported manner, that “[s]ince Oyama’s provisional application was filed before the applicants national phase of PCT application, the Oyama reference is eligible as prior art under 35 U.S.C. § 102(e).” Id.

Importantly, however, the M.P.E.P. mandates that “[t]he subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e).” The Manual of Patent Examining Procedure (8th ed., rev. 7, July 2008) (“M.P.E.P.”) § 706.02(f)(1)(I)(C)(1). The Examiner has not cited, nor has Applicant found, any recitation in provisional application no. 60/479,156 that supports the subject matter that the Office Action relies upon as disclosing “negotiating the provision of said mobile IP service via said authentication protocol over said pass-through transport, wherein negotiating the provision of said mobile IP service comprises authorizing said mobile node to use said mobile IP service and communicating to said mobile node a set of options for use of said mobile IP service,” as recited in Applicant’s independent claims 119 and 151. (Emphasis added). Specifically, the Final Office Action cites paragraphs [0086], [0088], [0192], and [0193] as purportedly exemplary recitations of Applicant’s “negotiating the provision of mobile IP service.” However,

Applicant has not found, nor has the Office Action pointed to, any specific recitation in provisional application no. 60/479,156 that supports the subject matter recited in these paragraphs.

Simply put, the content of Oyama and its provisional application are not the same. Provisional application no. 60/479,156 is directed to MIPv6 service, and not the HMIPv6 service that is described in Oyama. Therefore, at least the portion of the subject matter in paragraphs [0086], [0088], [0192], and [0193] of Oyama that recites features of the HMIPv6 service is not disclosed in provisional application no. 60/479,156. Therefore, as mandated by the M.P.E.P., at least this portion of the subject matter used in the rejection is not entitled to the earlier filing date under 35 U.S.C. 102(e) and, therefore, is not prior art against Applicant's claimed invention.

Because the filing date of Applicant's application is before Oyama's critical reference date under 35 U.S.C. § 102(e), and because it does not appear that the subject matter that the Office Action relies on in support of the claim rejection under Section 102(e) is disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, the Examiner has not established that the relevant portions of Oyama qualify as prior art under 35 U.S.C. § 102(e). Accordingly, the 35 U.S.C. § 102(e) rejection of independent claims 119 and 151 based on Oyama should be withdrawn. Further, each of claims 120-143, 145-150, 152-175, and 177-182 depend, either directly or indirectly, from one of independent claims 119 and 151, and the rejection of those dependent claims over Oyama should be withdrawn as well.

Moreover, independent claims 119 and 151 recite "negotiating the provision of said mobile IP service via said authentication protocol over said pass-through transport,

wherein negotiating the provision of said mobile IP service comprises authorizing said mobile node to use said mobile IP service and communicating to said mobile node a set of options for use of said mobile IP service.” Regardless of its status as prior art, Oyama fails to disclose or render obvious at least this recited subject matter.

Oyama discloses a system and method for supporting hierarchical mobile IP services. Each of the system and method employs the Hierarchical Mobile IPv6 (HMIPv6) protocol to reduce the amount of signaling between a mobile node, its correspondent nodes, and its home agent by introducing a mobility anchor point (MAP) located in the visiting network. Oyama at paragraph [0004]. A MAP is a node in a network where the mobile node maintains a permanent address and a mapping between the permanent address and the local temporary address where the mobile node happens to be currently located. Id. at paragraph [0005]. According to Oyama, the system defines an extended EAP authentication protocol that carries HMIPv6-related information facilitating discovery of MAP, dynamic allocation of MAP, dynamic allocation of a Regional Care-of Address (i.e., the local temporary address of the MN stored associated with the MAP’s subnet), distribution of security key(s) between MN and MAP, and/or possible piggyback of HMIPv6 mobility procedures. Id. at paragraphs [0005] and [0086]. HMIPv6-related information “may be normally regarded as part of the overall authorization procedure.” Id. at paragraph [0021]. That is, HMIPv6-related information corresponds to the phase of the process that authorizes a mobile node to use a visited network.

However, providing information for authorizing a mobile node to use a visited network, as described in Oyama, does not constitute “negotiating the provision of said

mobile IP service via said authentication protocol over said pass-through transport, wherein negotiating the provision of said mobile IP service comprises authorizing said mobile node to use said mobile IP service and communicating to said mobile node a set of options for use of said mobile IP service,” as recited in Applicant’s amended independent claims 119 and 151. (Emphasis added). In fact, Oyama is altogether silent with respect to communicating options for use of a mobile IP service to a mobile node, and does not disclose or render obvious such subject matter.

Furthermore, none of the features in paragraphs [0086], [0088], [0192], and [0193] that were cited in the Final Office Action as purportedly disclosing Applicant’s claimed “options for use of said mobile IP service” (i.e., “information facilitating the discovery of MAP, dynamic allocation of MAP, RCoA, and distribution of security keys between the MP and MAP,” etc.) are identified by Oyama as “options for use of said mobile IP service.”

For at least the reasons noted above, Oyama fails to disclose or render obvious all of the subject matter recited in either of Applicant’s amended independent claims 119 or 151, even if the entire disclosure of Oyama were erroneously treated as prior art. Accordingly, the 35 U.S.C. § 102(e) rejection of amended independent claims 119 and 151 based on Oyama cannot be maintained and should be withdrawn. Further, each of claims 120-143, 145-150, 152-175, and 177-182 depend, either directly or indirectly, from one of amended independent claims 119 and 151 and should be allowable for at least the same reason that amended independent claims 119 and 151 are allowable. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 102(e) rejection with respect to claims 119-143, 145-175, and 177-182.

II. Claim Rejection Under 35 U.S.C. § 103(a)

In the Office Action, claims 144 and 176 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Oyama. Claim 144 depends from independent claim 119 and claim 176 depends from independent claim 151. For the reasons outlined above, the Examiner has not established that the relevant portions of Oyama qualify as prior art over Applicant's application or that Oyama discloses or renders obvious all of the subject matter recited in amended independent claims 119 or 151. Therefore, the 35 U.S.C. § 103(a) rejection of dependent claims 144 and 176 should be withdrawn.

III. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application, withdrawal of the claim rejections, and the timely allowance of pending claims 119-182.

The Office Action contains characterizations and assertions regarding the claims and the cited art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant respectfully declines to automatically subscribe to any characterizations or assertions included in the Office Action.

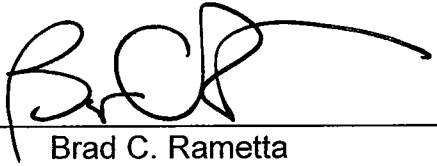
If the Examiner believes that a conversation might expedite prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned representative.

Please grant any extensions of time required to enter this Reply and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 2, 2009

By: 
Brad C. Rametta
Reg. No. 54,387
(404) 653-6552